

REMARKS

Claims 1 and 2 have been amended in a sincere attempt to place the case in condition for allowance. The phrase "do not" has been placed before the phrase "form a saturated or unsaturated carbon ring" in both claims 1 and 2. The change is believed to overcome the rejection of all claims (1 to 15) under the second paragraph of 35 USC 112. The change is designed to make explicit that which was believed implicit with the last Amendment.

The rejection of all claims on formal grounds is now believed moot. Should the Examiner, after review of the response, believe that other language is more appropriate, she is asked to contact the undersigned to discuss the matter.

The rejection of claims 1 to 10 and 13 under 35 USC 102 as anticipated by Hosokawa et al. '199 is respectfully traversed. Applicants respectfully submit that the breadth of the disclosure in the reference is not a proper teaching or suggestion of the subject matter claimed here. The general mention in the patent in the Abstract; column 2, lines 62 to 65, and claim 1 of mono-, di-, tri-, or tetrasteryl derivatives

containing amine does not properly teach the invention claimed here. As the Court of Customs and Patent Appeals remarked in In re Luvisi et al. 144 USPQ 645 (CCPA 1965) in note 2 at page 650:

To be sure, the language 'sodium borates' is present and borax is a sodium borate. But an expression which *includes* numerous species does not, necessarily, ipso facto 'disclose' each and every one of those species. As so aptly stated by appellants, 'It is possible for a patent to *include* a wide variety of subject matter but at the same time not to *disclose* a particular subject matter.' (Emphasis ours.) We might add that the reference need not be a patent. Our approach to this question is to ask whether or not it can fairly and reasonably be said that one of ordinary skill in this art through a reading of the entire reference has constructive possession of *the thing itself*, as opposed to possession of mere language which *embraces* the name of that thing.

Applicants respectfully submit that the same situation applies here.

Applicants moreover point out that the priority date of the present application is September 1, 2000, a date before the U.S. filing date of the Hosokawa et al. '199 patent.

The rejection of claims 1 to 14 (believed to be claims 1 to 15) under the judicially created doctrine of obviousness-type double patenting allegedly as unpatentable over claims 1, 4, and 9 of Hosokawa et al. '199 is noted. Although applicants do not

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agree with the merits of the Examiner's position, enclosed is a Terminal Disclaimer, which will moot the rejection.

Reconsideration of the case is earnestly solicited.

Respectfully submitted,

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Date

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Enclosure: Terminal Disclaimer

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